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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/255,107	02/22/1999	ROBERT B HARKNESS	2747-51635/K	8000

7590

06/28/2002

KLARQUIST SPARKMAN CAMPBELL
LEIGH & WHINSTON
ONE WORLD TRADE CENTER SUITE 1600
121 S W SALMON STREET
PORTLAND, OR 97204

EXAMINER

LOCKER, HOWARD J

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 06/28/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on April 08, 2002

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~The claim is~~ The claim is ~~pending~~ pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ ~~The claim is~~ The claim is ~~rejected~~ rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

09/255107
PTOL-326 (Rev. 10/95)

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

1. The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known cultivars and antecedents.

More specifically:

A. During a search of UPOV-ROM, the following "hits" on a rose cultivar named 'HARYUP' were found:

- (1) AU PBR 96231;
- (2) GB PBR 00501357; and
- (3) and NZ PBR ROS511.

While these earlier filed foreign documents would appear to be drawn to the same plant given the limited information available on UPOV-ROM, it cannot conclusively or positively be determined that such is the case.

Applicants must substantively address and obviate this issue responsive to this Office action (so as to provide as complete a description of the plant as is reasonably possible) by one of the two avenues mentioned below:

(1) If each of the above are indeed drawn to the same rose plant as is presently described and illustrated (i.e. the instant plant), such needs to be positively and clearly acknowledged in applicants' comments responsive to this Office action. In the alternative, applicants could file a substitute declaration incorporating these earlier prior foreign filings so as to clarify the issue should such be found to be the case, even though foreign priority is not being claimed (and in this instance cannot be claimed);

(2) If any or all of the above earlier filed referenced foreign documents refer to a different rose plant, it would be necessary for applicants to take corrective action relative to the cultivar name of the plant presently described and illustrated (i.e. the "instant" plant) such as by correcting same, as reuse of the cultivar name 'HARYUP' would then be

inadmissible under at least Article 48, Article 50, and Article 51 of the
***INTERNATIONAL CODE OF NOMENCLATURE FOR CULTIVATED
PLANTS-1980.***

As plant names are associated with and used to identify particular plants and are therefore descriptive, for a United States Plant Patent to properly issue, the cultivar name set forth in the specification must be acceptable.

B. The species designation for the instant plant should not be capitalized.

C. Throughout the written description, including in the claim and abstract, the descriptor "improved" is used with reference to floriferousness and disease resistance, but it is not clear what the instant cultivar is being compared to in this regard (i.e. the parental cultivars, climbing roses in general, pink climbers in particular, the species in general, what?). Correction and/or clarification is necessary. The specification should be drafted in positive and meaningful terms so as to describe the plant as completely as is reasonably possible. Relative to the issues set forth herein, applicant would perhaps be better served by setting forth in a more positive fashion the specific disease resistance(s) exhibited (in this regard, it is noted that the plant is stated to be susceptible to blackspot), as well as explicitly setting forth observed and characteristic flowering propensity in a positive fashion.

D. At lines 19-20 of page 1, if applicant is referring to hardiness zones, the specification should positively so state.

E. Rather than reciting, "(patent not applied for)" at lines 6-7 of page 2, applicant should simply state "(not patented)".

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F. If information is available for the plant when grown on its own roots, such should be imported into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible. In addition, the specification should set forth the rootstock (at least by Genus/species) onto which the plant as described and illustrated was budded.

G. If information is available relative to hip/seed formation, such should be imported into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible. In this regard it is noted that a hip is illustrated.

H. Rather than reciting "Color: Not tested." for pollen, the specification should include a positive statement as to whether or not pollen is formed, and some mention of the relative quantity and coloration thereof (if formed).

The above listing may not be comprehensive. Applicants should carefully review the disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant, for the reasons set forth in paragraph 1 above.

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by its Serial Number and filing date is required. See MPEP 602.01 and 602.02. The oath or declaration is defective because:

Non-initialed alterations have been made to the oath or declaration (see 37 CFR 1.52(c) and 1.57).

In addition, the validity of the information added cannot be corroborated, a certified copy of the referenced document was not furnished, a copy of the document per se could not be located by the examiner, and a claim for priority per se is improper given that more than one year passed (in this case 7+ years per the penned in date) prior to the filing of the United States application (see paragraph 4 below).

4. Acknowledgement is made of applicant's claim for priority under 35 U.S.C. 119 based upon an application filed in the United Kingdom on 07/20/92. A claim for priority under 35 U.S.C. 119 cannot be based on said application, since the United States application was filed more than twelve months thereafter.

5. Applicant has filed 3 separate requests for corrected filing receipts. All of same have been entered into the case, and the inventorship now reads: ROBERT B. HARKNESS, MOUGINS, FRANCE; PHILIP A. HARKNESS, HITCHIN, HERTS, ENGLAND. The filing receipt also shows 1 sheet of drawings present instead of 3 as was erroneously originally entered.

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6. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.

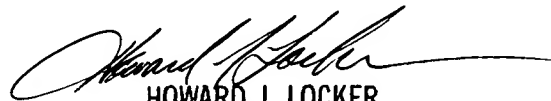
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl

June 20, 2000


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661